

REMARKS

Claim 5 is pending in this application. By this Amendment, claim 5 is amended to correct informalities noted in the Office Action. Support for the amendments to claim 5 may be found in Figs. 24 and 25, and the accompanying discussion of those figures on page 67-72, for example. No new matter is added. Reconsideration of the application in view of the above amendments and the following remarks is respectfully requested.

Entry of the amendments is proper under 37 C.F.R. §1.116 because the amendments place the application in condition for allowance for the reasons discussed below by merely satisfying requirements of form asserted in the Office Action. The amendments are necessary and were not earlier presented because they are made in response to assertions made in the final rejection. Entry of the amendments is thus respectfully requested.

The Office Action objects to the drawings. The amendments to claim 5 obviate the objection. Withdrawal of the objection to the drawings is respectfully requested.

The Office Action rejects claim 5 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. This rejection is respectfully traversed.

The amendments to claim 5 obviate the objection. The test for compliance with 35 U.S.C. §112, second paragraph is whether one skilled in the art would understand the bounds of the claims when read in light of the specification. *Miles Lab., Inc. v. Shandon Inc.*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993), *cert. denied*, 510 U.S. 1100 (1994). If the claims, read in light of the specification, reasonably apprise those skilled in the art of the scope of the invention, §112 demands no more. *See, also, In re Merat*, 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975) (stating that the question under §112, second paragraph is whether the claim language, when read by a person of ordinary skill in the art in light of the specification, describes the subject matter with sufficient precision that the bounds

of the claimed subject matter are distinct. *See, also, In re Warmerdam*, 33 F3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). This standard is met with claim 5 as amended.

Accordingly, reconsideration and withdrawal of the §112, second paragraph, rejection of claim 5 are respectfully requested.

The Office Action rejects claim 5 under 35 U.S.C. §103(a) over JP-A-64-016346 to Satoru, and rejects claim 5 under 35 U.S.C. §103(a) over Satoru in view of U.S. Patent No. 5,053,971 to Woods. These rejections are respectfully traversed.

This application claims that a number of revolutions of the plastic lens is calculated based on a type of material of the plastic lens, an edge thickness of the plastic lens being machined, a kind of machining and the turning speed of the plastic lens.

The Office Action acknowledges that Satoru does not disclose the thickness of the lens. The Office Action asserts that "one of ordinary skill in the art would have known that desired finish and/or rough machining would directly depend on the thickness of the work."

This application discloses that a number of revolutions of the plastic lens is calculated based on the edge thickness (Fig. 25). The Office Action's assertion that a skilled artisan would have known that desired machining would depend on the thickness of the work is not supported by any disclosure in Satoru. Further, the Office Action only relates "desired machining" to the edge thickness. The Office Action does not assert that a number of revolutions of the plastic lens is calculated based on the edge thickness. Thus, even in view of the Office Action's unsupported assertion about what the skilled artisan would have known, Satoru would not have suggested that a number of revolutions of the plastic lens is calculated based on the edge thickness, as recited in claim 5.

The Office Action also relies on Woods as supplying the edge thickness feature. Woods only discloses, however, "verify[ing] that there will be sufficient thickness at the peripheral edge of the cut lens to permit beveling." Verifying that there will be sufficient

thickness cannot reasonably be considered to correspond to calculating a number of revolutions of the plastic lens, as recited in claim 5. Thus, Woods does not supply the subject matter missing in Satoru.

In view of the above, Satoru and Woods, individually, or in combination, would not have suggested the combination of features recited in claim 5.

Accordingly, reconsideration and withdrawal of the obviousness rejections of claim 5 are respectfully requested.

Applicants made essentially the above arguments in a previous Request for Reconsideration. In response to those arguments this Office Action alleges that "because of the indefiniteness, it is unclear what the scope of the invention is, and the features of the claimed invention as best understood are met by modified Satoru. Applicants are very concerned with the prosecution of this application to date, as discussed below. This application was filed on July 3, 2003. A first Office Action was mailed on April 15, 2004. That Office Action was the first of now nine Office Actions in this application including at one point indicating that the claims, as written, were allowed. Applicants are concerned about the piecemeal prosecution of this application to date. There is further concern regarding the Examiner's assertions, at this point in examination of this application, that he does not understand the subject matter of the pending claims, or does not understand how the features recited in the claims find support and definiteness from Applicants' disclosure, as originally filed. The Office Action, as noted above, fails to specifically address the arguments made regarding the prior art rejections in Applicants previous request. For the totality of the shortfalls in the prosecution of this application to date, Applicants respectfully request under the provisions of MPEP Section 707.02 that, because this application has long passed its third Action, and five years of pendency, any further Office Action to be mailed regarding this

application be personally checked by a Supervisory Patent Examiner in an effort to satisfactorily complete prosecution of this application toward allowance.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claim 5 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

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